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This Opinion is Not Citable as Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Earthstone International LLC

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Serial No. 76434394

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Robert W. Becker of Robert W. Becker & Associates for Earthstone International LLC.

Frederick M. Mandir, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Quinn, Hairston and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Earthstone International LLC [applicant] has applied to register the mark PURE CLEAN for goods identified, following amendment, as "abrasive preparation for use for cleaning, removing stains, polishing and smoothing surfaces, in institutional and residential use," in Class 3. Applicant has disclaimed the exclusive right to use CLEAN apart from the mark proposed for registration.

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The refusal is based on the prior registration of the mark PURE CLEAN for "hand cleansers, hair shampoos and skin lotions for use in industrial and institutional facilities," in Class 3,[1] and the prior registration of the mark PURE 'N CLEAN for "cloths for wiping, cleaning and dusting," in Class 21.[2] The former of these two cited registrations (for the mark PURE CLEAN) includes a disclaimer of CLEAN.

After the refusal of registration was made final, applicant filed an amendment alleging use of its mark (the application had been filed under the intent to use provision of the Trademark Act), and subsequently filed two requests for reconsideration. The amendment to allege use was accepted; each request for reconsideration was denied.

Applicant's appeal has been fully briefed, but applicant did not request time for presenting oral arguments. The only issue to be decided on appeal is the refusal of registration under Section 2(d).

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[1] Registration no. 2021921 issued December 10, 1996 and an affidavit or declaration of use under Section 8, 15 U.S.C. § 1058, has been filed.

[2] Registration no. 2511213 issued November 20, 2001.

The examining attorney has argued, addressing first the marks in the cited registrations, that the PURE CLEAN mark is identical to applicant's mark and that the PURE 'N CLEAN mark is "highly" or "very" similar to applicant's mark; that when marks are identical or highly similar, for a likelihood of confusion to exist the goods need not be as close as they would have to be if the marks bore only some similarity; that goods need not be competitive or physically alike and only need be related in such a way that consumers would consider them to emanate from the same source or have common sponsorship; and that applicant's abrasive preparation for various purposes and for use in, inter alia, institutional settings, the first registrant's "hand cleansers… for use in… institutional facilities,"[3] and the second registrant's "cloths for wiping, cleaning and

[3] In analyzing the likelihood of confusion under Section 2(d), and in particular in comparing applicant's goods with those listed in the first of the two cited registrations, the examining attorney clearly has argued that a likelihood of confusion exists only insofar as the first of the cited registrations covers hand cleansers for use in institutional facilities; by implication he does not view confusion as likely insofar as the first registration covers hand cleansers for industrial facilities or hair shampoos and skin lotions for use in industrial or institutional facilities. In other words, while the first of the cited registrations covers three products (hand cleansers, hair shampoos and skin lotions) for use in two different types of settings (industrial or institutional), the examining attorney is only concerned with use of one of the products (hand cleansers) in one of the settings (institutional). It appears the examining attorney reasons that hand cleansers could be abrasive, i.e., they could have a characteristic like that of applicant's goods, but hair shampoos and skin lotions would not be abrasive.

dusting," would all be presumed by consumers to come from the same source.

To support his argument, the examining attorney relies on third-party registrations showing that marks have been registered for goods that are identical to, or closely related to, the goods of applicant and the goods listed in the cited registrations. He also contends that the goods of applicant and the two registrants are inexpensive and would be the subject of impulse purchases made with less care than would be exercised in regard to purchases of more expensive goods. Finally, he contends that applicant's goods would be perceived by consumers to be within the natural zone of expansion for each of the registrants.

In each of its briefs, applicant makes a passing reference to the mark in the second of the two cited registrations, i.e., PURE 'N CLEAN, which applicant contends "differs aurally and visually" from its own mark; but applicant also allows in its reply brief that the involved marks are "similar in appearance." Applicant's principal argument against the refusal of registration is that the third-party registrations introduced by the examining attorney do not establish a likelihood of confusion among typical consumers of the involved goods, exercising ordinary caution, but only demonstrate the mere

possibility that a merchant could adopt the same mark for goods traveling in different "streams of commerce."[4] Applicant also argues that its goods are not similar to those in either of the cited registrations and that applicant's stream of commerce differs from those of the registrants.

As for the goods listed in the first of the two cited registrations, applicant contends its abrasive product for cleaning, removing stains from, polishing and smoothing surfaces and the registrant's "personal hygiene" products clearly are dissimilar, and that a typical consumer exercising ordinary caution would not confuse them. As for the goods in the second of the cited registrations, applicant contends that cloths for wiping, cleaning and dusting, being inherently soft in nature, "cannot be" an abrasive preparation such as applicant's product; would be used only for non-abrasive cleaning; and a typical consumer exercising ordinary caution would not confuse them.[5]

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[4] While applicant characterizes this argument as contending that the examining attorney utilized the wrong test for likelihood of confusion, i.e., mere possibility of confusion rather than likelihood of confusion, it is essentially an argument that the evidence on which the examining attorney relies is insufficient to prove likelihood of confusion.

[5] In arguing that its product would not be confused with a soft cloth, applicant states that its product, though termed an "abrasive preparation" in the identification, is an "abrasive block." While that may be so, we must assess relatedness of the

Applicant also contends that "unlike several" of the third-party registrations on which the examining attorney relies, that are for house marks, the cited registrations are not for house marks; and while a typical consumer exercising ordinary caution might expect to find a house mark on diverse products, such a consumer would not expect to find a "non-house mark" on different products in different streams of commerce. Finally, applicant contends that consumers utilize packaging to differentiate products and their sources.

As to its contention regarding streams of commerce, applicant asserts that the concurrent registration of the two cited registrations is evidence that the products identified therein must travel in different streams. Applicant also relies on the limitation in the identification for the PURE CLEAN personal hygiene products

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goods based on identifications, not actual products. See Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Moreover, in comparing goods listed in a registration and an application we are assessing their relatedness and, if related, the likelihood of confusion if the goods were marketed under the same or similar marks. We are not assessing whether one product could be confused for another.

that they are sold "for use in industrial and institutional facilities; and it contends that the market for cleaning cloths is very different from the market for abrasive cleaners.

In its reply brief, applicant largely repeats arguments made in its main brief and posits numerous hypothetical situations involving asserted house marks and product marks, situations in which it asserts that consumers would not be likely to be confused. Applicant analogizes these situations to the circumstances presented by comparison of its application and the cited registrations.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the typical analysis of likelihood of confusion, key considerations are the similarities or dissimilarities of the marks and the question whether the goods are related in some way. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

As to all three of the involved marks, we note that they are very highly suggestive. "Clean" has been

disclaimed in two of the marks and "Pure" is clearly a suggestive term when considered in connection with the various involved products.[6] See, for example, the following definition of "pure": "8. clean, spotless, or unblemished." The Random House College Dictionary 1073 (revised ed. 1982). Thus, in our comparisons of applicant's mark and each of the marks in the cited registrations, we adopt the view that the marks are entitled to a limited scope of protection.

Considering the marks individually, the mark in the first of the cited registrations is identical to that of applicant, which weighs heavily against applicant. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). This is true notwithstanding our conclusion that the involved marks are entitled to only a limited scope of protection, for even a highly suggestive or weak mark is entitled to protection. Cf. In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982).

When marks are identical, as are applicant's mark and the mark in the first of the cited registrations, their contemporaneous use can lead to the assumption that there

[6] The fact that "Clean" is not the subject of a disclaimer for the PURE 'N CLEAN mark, even though it is registered for, inter alia, "cloths for… cleaning" may be attributable to the Office's policy of not requiring disclaimers of a word that is part of a

is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). The examining attorney has put into the record printouts of information regarding a number of registrations, and one intent-to-use application, to establish that the same mark has been registered for, on the one hand, hand cleaners, and on the other, surface cleaners. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). See also, In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), aff'd as not citable precedent 88-1444 (Fed. Cir. Nov. 14, 1988).

Three of the registrations proffered by the examining attorney must be disregarded, because they are not based on use of the registered marks, and the intent-to-use application likewise is not probative. Nonetheless, there are still four other registrations that are based on use, and cover both hand cleaners of some type and surface

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unitary phrase. See TMEP Section 1213.05 (third ed. rev. 2, May 2003).

cleaners of some type. In fact, two of these registrations specifically list both abrasive surface cleaners and hand cleaners. We find these third-party registrations probative evidence that consumers would conclude, when seeing the identical mark used on or in conjunction with applicant's products and the hand cleanser listed in the first of the cited registrations, that they had a common source or sponsor.

Finally, we note that the identifications in both applicant's application and the first of the cited registrations list institutional customers as a class of consumers for the identified products. This, too, contributes to a likelihood of confusion.

We affirm the refusal of registration under Section 2(d) based on the first of the cited registrations. On the other hand, we reverse the refusal as to the second of the cited registrations.

As noted above, we consider the involved marks to be entitled to only a very limited scope of protection. The mark and goods applicant proposes to register intrude on that scope of protection only for the first of the cited registrations. The mark in the second of the cited registrations, PURE 'N CLEAN, is different. Clearly, the differences are slight, but when the marks are not entitled

to broad protection, slight differences may contribute to a finding of no likelihood of confusion. See, e.g., In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)(No likelihood of confusion between BED & BREAKFAST REGISTRY for "making lodging reservations for others in private homes" and BED & BREAKFAST INTERNATIONAL for "room booking agency services."); Hard Rock Cafe Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1409 (TTAB 1998)(Stating, "in view of the suggestive nature of opposer's marks, as discussed herein, we do not accord to opposer's marks a broad scope of protection as would be warranted if fame had been established" the Board found no likelihood of confusion between opposer's HARD ROCK CAFE marks and applicant's COUNTRY ROCK CAFE mark.). Moreover, applicant's "abrasive preparation for use for cleaning, removing stains, polishing and smoothing surfaces, in institutional and residential use," is a different product than the second registrant's "cloths for wiping, cleaning and dusting." Though the third-party registrations the examining attorney entered into the record are sufficient to show that consumers likely would attribute applicant's goods and those of the first registrant, when sold under the identical mark, to a common source, these registrations

largely do not support a refusal of registration based on the second of the cited registrations.

Only one of the four registrations that are based on use of the marks in commerce covers both a product like applicant's and products like that of the second registrant. Moreover, that registration, no. 1279488, is for a mark that is clearly a house mark (the mark is CLEVELAND COTTON PRODUCTS and so is registrant's name).

In short, given the limited scope of protection to be accorded PURE 'N CLEAN for wiping cloths and PURE CLEAN for applicant's products, the differences in the goods, and the paucity of evidence showing that such products typically have a common source or sponsor, we reverse the refusal of registration based on the second registration.

Decision: The refusal of registration under Section 2(d) is affirmed as to the first of the two cited registrations but is reversed as to the second of the two cited registrations.